

Application No.: 09/964,143

5,891,449) and Gagnebien et al. (U.S. Patent No. 5,888,951). According to the Examiner, Zobotto et al. teach a cleansing composition containing 50-95% oily phase, 1-30% of an emulsifying agent and 1-10% of particulate abrasives. The particulate abrasives of Zabotto et al. are described as "hydrosoluble". Examiner combined the teachings of Zabotto et al. and Barker et al. asserting that Barker et al. disclose an oil phase cleansing composition with water soluble abrasive particles such as sodium chloride suspended in the oil phase. Presumably, the Examiner is concluding that it would be within the skill of the art to use sodium chloride for the "hydrosoluble" particulate abrasives in Zabotto et al.

Claim 44, the sole independent claim in the application, requires that the particulate material be a combination of 8-20% of a starch and a particulate such as sodium chloride, pumice, talc or a vegetable flour. This combination is not taught or suggested by Zabotto et al. or Barker et al., either taken alone or in combination.

The Examiner acknowledges that the primary references "do not teach expressly the particular percentage of each and every ingredient herein claimed that, or the employment of particular ingredients, such as particular abrasive agents, particular oil, calcium stearate, or the employment of sodium chloride, pumice, kernel starch as particular ingredients, and sodium cocoyl N-methyl taurate as the surfactant." For these deficiencies, the Examiner relies on no less than six references.

The rejection relies on Kellner et al. as teaching a water and oil emulsion. However, the rejection does not explain why and how it would be within the skill of the art to combine this teaching with Zabotto et al. and Barker et al. Both Zabotto et al. and Barker et al. are directed to anhydrous compositions, while Kellner et al. is not anhydrous. While the Kellner composition

Application No.: 09/964,143

may include emollients, oil phase gelling agents, primary gelling agents, surfactants and particulates, there is no cogent reasoning set forth in the rejection as to how one skilled in the art would modify Zabotto et al. and Barker et al. to arrive at the claimed invention from the teachings of Kellner et al. Further, Kellner et al. do not disclose or suggest the claimed a combination of a starch and the particulates as set forth in claim 44.

The rejection further relies on Stewart et al., Geria, Daniel et al., McAtee et al. and Gagnebien et al. for limited teachings regarding the thickening properties of calcium stearate, the use of pumice or kernel flour as the particulate material, the use of sodium cocoyl N-methyl taurate as the surfactant, and the use of macadamia oil in cleansing compositions. The rejection, however, fails to provide any cogent reasoning as to how and why a person of ordinary skill in the art would have been led from the combined teachings of the references to modify Zabotto et al. and Barker et al. to combine these ingredients and arrive at the invention recited in claim 44.

The Examiner's conclusion of obviousness is merely a conclusion without presenting any cogent reasoning as to how and why the ingredients identified in the references would have led a person skilled in the art to combine the ingredients in the specific percent ranges set forth in claim 44.

In addition, the prior art relied upon by the Examiner, taken individually or in combination, fail to disclose or suggest an exfoliating cosmetic composition which is stable and which does not leave a greasy or tacky after-feel when the composition is applied to and rinsed from skin with water. These properties of the composition are set forth in the preamble of independent claim 44. None of the references relied upon by the Examiner present a teaching that would lead a person skilled in the art to expect that, for example, 10% to 45% by weight of a

Application No.: 09/964,143

non-irritating, mildly abrasive particulate material that effectively cleanses and lubricates the skin without a breaking the skin.

Furthermore, the references fail to disclose or describe that 0.4% to 8.0% by weight of a surface active agent forms a stable composition that effectively leaves a thin-film of the emollient material on the skin which effectively softens, smoothes and moisturizes the skin without leaving a greasy or tacky after-feel when the composition is removed from the skin with water and then dried. These are features of the invention set forth in the body of the independent claim which are not taught or suggested by the prior art relied upon by the Examiner.

Attached is a Declaration by Lauren Trahan under 35 U.S.C. § 131 showing the results of testing by 30 panelists, who used the Barker et al product (PC) and other products. For reasons set forth in the Declaration, the Zabotto examples could not be reproduced because some of the ingredients are not currently available. In lieu of Zabotto example, it was necessary to find a close equivalent. For this reason, a Proctor and Gamble product (TE), as an example from McAtee et al, was used. While the Proctor & Gamble product is not a cream or gel like the examples in Zabotto, it is positioned as a product to both exfoliate and condition skin. Because it is a composition impregnated in a cleansing cloth (a towelette), it required special instructions for use. See Exhibit A of the Declaration. Also, for purposes of comparison, the claimed composition (EP) was compared to a commercially available salt scrub for hands (MM). To show the importance of the surfactant in the claimed composition (EP), a composition without the surfactant (NT) was used in the panel testing.

Application No.: 09/964,143

The results of the panel testing disclosed in the Declaration demonstrate that the product of the claimed invention (EP) was superior. See Paragraph 14 of the Declaration. The claimed composition was found by the panelists to feel better when applied and after rinsing than the Barker et al product and rinsed away better than the Barker et al. While product TE in some respects appeared to be better, it was a completely different product from the other products tested and the results do not reflect the composition only, but the effect of the combination of the towelette and the impregnated composition. See the special instructions for TE (Exhibit A) and the commentary of the results set forth in Exhibits C to F.

Claim 44 requires that the composition claimed does not leave a greasy or tacky feel after the product is rinsed from the skin. The claimed composition with the claimed surfactant (EP) had a significantly less greasy feel than the Barker et al. product (PC), the salt scrub (MM) and the claimed composition without the surfactant (NT). See paragraph 15 of the Declaration. As for product TE, it appears that the panelists felt the towelette more than the composition and for this reason there was a less greasy feel. See the commentary in Exhibit D.

Claim 44 further requires that the composition contain 0.4% to 8.0% by weight of a surface active agent to form a stable composition that effectively leaves a thin-film of the emollient material on the skin which effectively softens and smoothes the skin. Exhibit N demonstrates that the panelists found the claimed composition (EP), after rinsing, to provide smoother and softer feel than all other products tested (PC, MM, NT and TE). Overall, the panelists found that product EP as significantly better than the other products tested. See Exhibits O and P.

Application No.: 09/964,143

For all of the foregoing reasons, the combination of references relied upon by the Examiner do not present a *prima facie* case of obviousness. Under Federal Circuit guidelines, a dependent claim is not obvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims. *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as independent claim 44 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon, claims 45-59, are also patentable. It is respectfully requested that the rejection be reconsidered and withdrawn.

### **Conclusion**

For the foregoing reasons, it is submitted that the claims 44-59 are patentable over the teachings of the prior art relied upon by the Examiner. Accordingly, favorable reconsideration of the claims is requested in light of the preceding amendments and remarks. Allowance of the claims is courteously solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicant's attorney at the telephone number shown below.

A petition for a three-month extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. § 1.17 and due in connection with the

Application No.: 09/964,143

filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, appearing to read 'Cameron K. Weiffenbach', with a stylized, flowing script.

Cameron K. Weiffenbach  
Registration No. 44,488

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8171 CKW:ckw  
Facsimile: 202.756.8087  
**Date: December 31, 2007**

**Please recognize our Customer No. 20277  
as our correspondence address.**